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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,536	07/27/2001	Kevin Y. Chou	SP01-209	8547

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CORNING INCORPORATED
SP-TI-3-1
CORNING, NY 14831

EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/09/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/916,536		Applicant(s) CHOU ET AL.	
Examiner Rabon Sergent		Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,3,4,8</u> . | 6) <input type="checkbox"/> Other: |

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1. The election of species requirement has been withdrawn.
2. Claims 1-3, 7-24, and 28-46 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compositions comprising oligomers derived from the reaction of polypropylene glycol, hydroxyethyl acrylate, and either 4,4'-methylenebis(cyclohexylisocyanate) or isophorone diisocyanate, does not reasonably provide enablement for compositions wherein the oligomer is derived from virtually any polyol soft block. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Despite applicants' response, the position is maintained that applicants have not provided any guidance for the selection and use of components, other than the aforementioned ones, that will yield a coating composition having the claimed properties. Furthermore, the position is maintained that one of ordinary skill could not practice the claimed invention using components, other than those disclosed by the applicants, without having to resort to undue experimentation. In response, applicants have argued that the skilled artisan can rely on the examples of the specification as a guide for substituting oligomers having other soft polyol blocks with only a routine amount of experimentation. However, applicants have provided no evidence to support their argument that the skilled artisan can rely upon teachings pertaining to oligomers based on polypropylene glycol, hydroxyethyl acrylate, and either 4,4'-methylenebis(cyclohexylisocyanate) or isophorone diisocyanate as a guide to produce totally unrelated oligomeric species, such as polyesters, polycarbonates, or polysiloxanes, having the

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necessary properties, without having to resort to undue experimentation. As far as the examiner can determine, the specification sets forth no teachings that would guide one in the production of suitable oligomers that are derived from monomers other than the aforementioned ones; without such guidance, one cannot substitute radically different reactants and expect to obtain oligomers having the claimed physical properties.

3. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Markush group of oligomers is improper, because "and" prior to "combinations thereof" should be "or."

4. Claims 12 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of the claims fails to further limit claims 1 and 22, because it is unclear that the species, "propylene oxide ethoxylated oxides", is unsaturated. Furthermore, it is questioned if this species has been claimed correctly.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

~~A person shall be entitled to a patent unless -~~

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 7, 12-15, 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Chawla ('023).

Patentee discloses radiation curable coatings, having tensile strength and modulus characteristics corresponding to those claimed, comprising the reaction product of an oligomer and unsaturated monomer which meet applicants' reactants. See Comparative Examples A and C.

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7. Claims 1-3, 7, 13-15, 18-24, 28, 34-36, and 39-42 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1046619.

The reference discloses a coated optical fiber, wherein the fiber is coated with a radiation curable composition, having tensile strength and modulus characteristics corresponding to those claimed, comprising the reaction product of an oligomer and unsaturated monomer which meet applicants' reactants. See abstract and examples.

8. Claims 1, 2, 7, 13-18, 20-23, 28, 34-40, and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 99/08975.

The reference discloses a coated optical fiber, wherein the fiber is coated with a radiation curable composition, having tensile strength and modulus characteristics corresponding to those claimed, comprising the reaction product of an oligomer and unsaturated monomer which meet applicants' reactants. See abstract and examples.


9. Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/08975.

WO 99/08975 discloses a coated optical fiber, wherein the fiber is coated with a radiation curable composition, having tensile strength and modulus characteristics corresponding to those claimed, comprising the reaction product of an unsaturated oligomer, produced by reacting a polyol, a polyisocyanate, and a hydroxy functional ethylenically unsaturated compound; and an unsaturated monomer. The reference further discloses that the oligomers have a preferred molecular weight of 5,000 to 20,000.

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10. In view of the teachings within the reference pertaining to the use of reactants which correspond to the reactants utilized by applicants and in view of the fact that the reference discloses that the oligomer should have a preferred molecular weight of at least 5,000 and that the cured coatings have physical properties that are beneficial for the protection of optical fibers, the position is taken that it would have been obvious to one of ordinary skill in the art to follow these teachings, so as to arrive at the instant invention.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent
June 4, 2003